

Remarks and Arguments

The above amendments and these remarks and arguments are responsive to the Office action dated October 20, 2006, on the above-identified patent application. Claims 26–37 are pending in the application. Claims 26–28, 33, and 34 have been amended herein to more particularly point out and distinctly claim aspects of the invention. Support for these amendments is found throughout the specification, including but not limited to Figures 1–4 and 6; page 4, lines 12–14; page 6, lines 16–17; and the claims as originally filed. New claims 44–47 have been added herein to more particularly point out and distinctly claim aspects of the invention. Support for these new claims is found throughout the specification, including but not limited to page 8, lines 1–4; page 2, lines 6–18, and Figures 1 and 5.

I. 35 U.S.C. § 102

Claims 26, 27, 30, 32, 34, 35, and 36 stand rejected as allegedly anticipated under 35 U.S.C. § 102 (e) by U. S. Patent No. 6,908,737 (hereinafter “Ravkin”). Applicants traverse the rejections.

The standard for anticipation under 35 U.S.C. § 102 requires that “each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). “The identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

According to the Office, Ravkin discloses a system for performing a multiplexed experiment including a set of particles each having an optically detectable code. The Office believes that alternative embodiments include multi-layered particles having different optical properties such as different polarizations.

Claim 26 and its dependencies have been amended to recite in part: "the light polarizing material is distributed on a portion of a substrate surface or embedded within a portion of a substrate surface." Ravkin does not disclose a light polarizing material **distributed on a portion of or embedded within a portion of** a substrate surface. Ravkin therefore does not teach each and every element of the claim and accordingly is not anticipatory. Withdrawal of the rejection is respectfully requested.

II. 35 U.S.C. § 103

Claims 28–29, 31 and 33 stand rejected as allegedly unpatentable over Ravkin. The Office believes that it would have been obvious to use a substrate with low absorption in the measurement range, in order to allow all of the incident light to be utilized for detection. The Office also believes that there would have to be some wavelength of light for which any polarization layer would have low polarization. The Office also alleges that absent any showing of criticality the size ranges would have been obvious. The Office further alleges that it would have been obvious to use perpendicular polarization because such a relationship would block all incident light and thus would be easy to detect. Applicants traverse the rejections.

II.A. The Prima Facie Case Requirement

The Patent and Trademark Office (PTO) bears the burden of initially establishing a prima facie case of obviousness. MPEP § 2142. MPEP § 2143 provides the standard required to establish a prima facie case of obviousness. “First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine what the reference teaches. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations.”

The motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The references must be considered as a whole and must suggest the desirability, and thus the obviousness, of making the combination. *Hodosh v. Block Drug Co., Inc.*, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP § 2141.

II.B. The Ravkin Reference Does Not Teach or Suggest All of the Claim Limitations

Claim 26 has been amended as set forth above. Ravkin does not teach the amended limitations. Claims 28–29, 31, and 33 depend on claim 26. Accordingly, Ravkin does not teach or suggest all of the claim elements and thus the claims are not prima facie obvious. Withdrawal of the rejections is respectfully requested.

Applicants additionally point out that the Office has pointed to nothing in Ravkin or any other reference of record to suggest that the elements of claims 28–29, 31, and 33 as originally filed are taught or suggested. In this regard the Office is reminded of its obligation not to use hindsight in rejecting a claim as allegedly obvious. Moreover, the Office is reminded that the art must teach or suggest not only all of the claim limitations, but demonstrate a reasonable expectation of success as well. *In re Vaeck* supra; MPEP §2143. The Office has not met its obligation in this regard either.

In limited circumstances, it may be appropriate for the Office to take official notice of facts not in the record or to rely on common knowledge in making a rejection. MPEP §2144.03. However, it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. *In re Zurko* 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Ordinarily, there must be some evidence in the record to support an assertion of common knowledge. *In re Lee* 61 USPQ2d 1430; 1434 (Fed. Cir. 2002). No such showing exists in the instant record.

For all of the reasons set forth above, withdrawal of the obviousness rejections is respectfully requested.


III. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the

pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 11-1540.

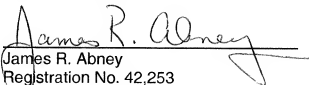
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